No. 77-1283

In the Supreme Court of the United States

OCTOBER TERM, 1977

KREKEL KARCH, PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

WADE H. MCCREE, JR.,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

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MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

Petitioner brought this action in the Court of Claims, pursuant to 28 U.S.C. 1498, seeking to recover from the United States compensation for infringement of patent No. 2,745,768,[1] which describes a process to control the runoff of rain water and suspended soil from watershed fields. Petitioner's patent uses the well-known concept of slowing the velocity of silt-laden water to such a degree and for such a length of time that a large proportion of the silt settles and is deposited on the ground, and a substantial amount of desilted water is soaked into the ground to increase the water table (Pet. App. 3a).

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[1]The term of a patent is 17 years. The patent was issued on May 15, 1956, and, accordingly, expired May 15, 1973 (Pet. App. 2a).

Petitioner contends that the Court of Claims erred in holding that his patent is invalid because its disclosures would have been obvious to a person having ordinary skill in the subject matter in light of the prior art (Pet. App. 2a).

The Court of Claims concluded that the patent is invalid because it is obvious within the meaning of 35 U.S.C. 103, as construed by this Court in *Graham* v. *John Deere Co.*, 383 U.S. 1 (Pet. App. 7a-13a). The court described some of the prior structures for stopping erosion and observed that one such method differed from petitioner's only in rate and structure by which water is removed (*id.* at 9a-11a). A second known method contained most of the ingredients of petitioner's approach (Pet. App. 11a). The Court concluded that one of ordinary skill in the art, considering the known value of silt as fertilizer, and the damage that results if water stands on crops for too long a time, would find obvious petitioner's solution of combining ideas from previous methods to maximize the silt deposit while providing for removal of water before it could cause crop damage. Cf. *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273.

Further review by this Court is unwarranted. Petitioner raises no signficant legal questions. Despite petitioner's contentions to the contrary (Pet. 14-26), the case turns on the factual determinations made by the Court of Claims, which are amply supported by the record.

Petitioner's contention (Pet. 27-46) that the court's finding of novelty under 35 U.S.C. 102 (Pet. App. 6a-7a) necessarily precluded a finding of obviousness under 35 U.S.C. 103 is insubstantial. Novelty and non-obviousness are cumulative requirements under the express terms of Section 103, which provides that a patent may not be

issued "though the invention is not identically disclosed or described as set forth in section 102" if the invention is also obvious.[2]

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

MAY 1978.

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[2]Petitioner's remaining arguments are frivolous. The court considered the "secondary considerations" petitioner cites (Pet. 47-59) but found them insufficient to tip the balance, where, as here, "obviousness is clear" (Pet. App. 13a n. 4).

Although petitioner asserts (Pet. 60) that the United States should be estopped to deny the validity of a patent that it had issued, it is well established that Congress intended all defenses available to a private party in an infringement suit to be available to the United States. See the Reviser's Note to 28 U.S.C. 1498, which states that a provision expressly allowing the United States to claim the defenses available to a private party was deleted as "unnecessary."

Petitioner's treble damage arguments (Pet. 59) need not be considered, since the Court of Claims found the patent invalid and did not reach the damages issue.

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